

Cole - Serial No.: 09/605,544
Responsive to Office Action of April 21, 2005

REMARKS

The non-final Office Action of April 21, 2005, has been carefully reviewed and these remarks are responsive thereto. Claims 1, 12, 16, and 20 have been amended, no claims have been cancelled, and no new claims have been added. Claims 1-10, 12-16, and 18-22 thus remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Rejection Under 35 U.S.C. § 112

Claims 1-10, 12-16, and 18-22 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement and failing to provide a written description of the invention. Applicant has amended claims 1, 12, 16, and 20 to refer to a “plugin” instead of a “plugin object.” As the Examiner points out, a plugin is supported by the specification. Office Action, p. 4. In light of these amendments, Applicant’s specification does provide written support and does meet the enablement requirement of 35 U.S.C. § 112, first paragraph.

With regard to claims 1, 16, and 20, the Office Action further argues that *containing* is very different from and is not supported by *attaching*, as is described in the specification. Office Action, p. 3. However, the specification states:

The present invention also allows for the attachment of one or more files to the software envelope by describing the attachments between a pair of <attachment> tags 510 for each attached file. The name of an attached file may be included between <filename> tags 512 and a textual description of the attached file may be contained within <description> tags 514. The type of file may be included between <type> tags 516.

Specification, p. 11. As is shown in Figure 5 and supported in the specification, a file attached to the envelope will be contained within <attachment> tags, which are further contained within the manifest of the envelope. Thus, a file *attached* to the envelope can similarly be said to be *contained* by the envelope. Given the structure of the software envelope described in the specification, there is no reasonable interpretation for the term “contained” that is not adequately supported by the description of “attached” files found in the specification. Accordingly, claims 1, 16, and 20, and their respective dependent claims, meet the requirements of 35 U.S.C. § 112, first paragraph.

Regarding claim 12, the Office Action argues that the data structure of claim 12, containing a

Cole - Serial No.: 09/605,544
Responsive to Office Action of April 21, 2005

plugin, is not supported by the specification. Office Action, p. 3-4. As discussed above, in regards to claim 1, the specification supports a plugin that is contained with a software envelope. Figure 5; Specification, p. 11. Accordingly, claim 12, and its respective dependent claims, meet the requirements of 35 U.S.C § 112, first paragraph.

Claims 1-10, 12-16, and 18-22 are also rejected under 35 U.S.C. § 112, second paragraph, for failure to point out and distinctly claim the subject matter of the invention. As described above, Applicant has amended claims 1, 12, 16, and 20 to refer to a “plugin” instead of a “plugin object.” As the Examiner points out, a plugin is supported by the specification. Office Action, p. 4. Accordingly, Applicant respectfully submits that all claims in this application meet the requirements of 35 U.S.C § 112, second paragraph.

Rejection Over Hughes and Dutta Under 35 U.S.C. § 103

Claims 1, 6-8, 10, 16, 19, 20, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,122,372 to Hughes (“Hughes”) in view of U.S. Patent No. 6,615,212 to Dutta et al. (“Dutta”).

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim features. See MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Claim 1 recites a method for exchanging data using a software envelope. As amended, the software envelope of claim 1 contains a data file and a plugin corresponding to the predetermined schema in accordance with which the data file is generated. Claim 1 further recites creating an object from the data file with the plugin. Neither Hughes, Dutta, nor the proposed combination of the two, teaches or suggests a plugin corresponding to a schema, or creating an object from a data file and a plugin. As the Examiner correctly points out, Hughes does not teach plugins at all. Office Action, p. 5. The Office Action instead relies on Dutta to disclose a plugin as claimed. However, in Dutta, the plugin is described only as a viewer for a type of media that the client is not equipped to view. For example, Dutta proposes sending a PNG image to the client, and including a PNG viewer to allow the

Cole - Serial No.: 09/605,544
Responsive to Office Action of April 21, 2005

client to view the image. Dutta, Col. 7, lines 63-67, Col. 8, lines 1-11. However, Dutta's plugin does not correspond to a *schema*, and does not allow for the creation of an object using the plugin with a data file, as is recited in claim 1.

In addition, Dutta does not teach or suggest a plugin in accordance with claim 1. The data file recited in claim 1 is generated with a markup language in accordance with a schema. A schema is a well-known term of art; it defines the structure and type of contents in a data file. Schemas and markup languages allow applications using Document Object Model (DOM) and similar technology to transform data into an object usable by the destination's system. Specification, p. 12. Dutta does not mention the term schema or describe the concept of a schema, and the plugin described by Dutta could not interact with data corresponding to a schema. Thus, Dutta's plugin does not correspond to a schema, and could not create an object from a marked-up data file, as is recited in claim 1. Therefore, even if Dutta was used to modify Hughes as proposed, the combination still would not result in the entire claimed invention of claim 1.

As stated above, in order to reject a claim as obvious under § 103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. See MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). In the present case, a valid motivation or suggestion in the prior art for combining Hughes with Dutta has not been set forth in the Office Action. The overall purpose of the Dutta invention is very different from the purposes of the Hughes invention. Hughes attempts to facilitate communication between incompatible systems. Hughes, Col. 2, lines 46-52. In contrast, Dutta is primarily concerned with increasing efficiency by using a "transcoding proxy server" to determine the format in which a file should be returned to the client. Dutta, Abstract, Col. 2, lines 26-36. Dutta does not address issues related to marking up data or transforming data for cross-system compatibility. Dutta simply makes an efficiency determination and then decides to (1) send the data, (2) convert then send the data, or (3) send the data with viewer rather than converting. Dutta, Abstract. Thus, the goals of the Dutta and Hughes inventions are unrelated, and there is no clear motivation to combine the two.

The Office Action provides an alleged motivation to combine the references, e.g., "This would have been an especially advantageous addition to the system disclosed by Hughes." Office Action, p. 6. However, simply noting the advantages of the Applicant's invention cannot provide a motivation

Cole - Serial No.: 09/605,544
Responsive to Office Action of April 21, 2005

in the prior art to have combined references. Rather, it is apparent that this conclusion could only have been reached after having benefited from reading Applicant's own disclosure, and thus constitutes impermissible hindsight. Thus, the Office Action does not present any motivation or suggestion in the references themselves, nor does the Office Action provide any evidence of the level of knowledge of one of ordinary skill in the art, as is required to make out a *prima facie* case of obviousness.

The Office Action further states that this combination would have been advantageous to Hughes, "since it would allow data files to be packaged with the appropriated plugin to ensure that the client can properly understand them." Office Action, p. 6. However, Hughes already allegedly ensures that clients can properly understand messages from incompatible systems:

A data structure and method are disclosed for encapsulating a message with a verifiable message ID and a verifiable identification of message interpretation information. The encapsulated message includes a message set and a data generated message identifier. The message set includes a message body that contains the content of a message and a data generated interpretation identifier that verifiably identifies an interpretation file that may be used to interpret the message body.

Hughes, Abstract. Thus, there is no motivation to add plugins to Hughes, since Hughes already alleges to have a system for interpreting messages transmitted between incompatible systems, and does so without using plugins in any way.

The Federal Circuit has repeatedly stated that the elements of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembicza*k, and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Thus, Applicants respectfully submit that that there is no motivation or suggestion to combine Hughes with Dutta. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of one of ordinary skill at the time the claimed invention was made. Nor does the Office Action provide any evidence that the combination includes knowledge gleaned from any source other than Applicant's disclosure. Thus, again, it can only be concluded that the combination is improperly based on hindsight.

Applicant therefore submits that amended claim 1 is allowable over Hughes and Dutta for at least the above reasons.

Cole - Serial No.: 09/605,544
Responsive to Office Action of April 21, 2005

Independent claim 16 has also been amended to describe a plugin “corresponding to the predetermined schema.” Accordingly, claim 16 and independent claim 20 are also allowable for at least similar reasons discussed above in relation to claim 1, and further in view of the various differences therein. Dependent claims 2-10, 18-19, and 21-22 are allowable for at least the same reasons as their respective base claims, as well as based on the additional features recited therein.

Rejection Over Lection and Dutta Under 35 U.S.C. § 103

Claims 12-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,446,110 to Lection et al. (“Lection”) in view of Dutta. For similar reasons to those described above in reference to claim 1, Lection and Dutta, alone or in combination, do not teach or suggest every aspect of amended claim 12. Specifically, Lection and Dutta do not teach or suggest a *plugin corresponding to the predetermined schema, or creating an object from the data file with the plugin*. The Examiner correctly points out that Lection, like Hughes, does not teach plugins sent along with data. Office Action, p. 12. Additionally, Dutta fails to teach plugins that correspond to a *schema*, or plugins that are used to create an object. Further, as is discussed above regarding claim 1, there is no motivation or suggestion for combining Lection with Dutta, given the unrelated purpose of the Dutta invention compared to Hughes and Lection inventions. Thus, Applicant respectfully submits that claim 12 is allowable over Lection and Dutta for at least the above reasons. Claims 13-15, dependent back to claim 12, are also allowable for at least the same reasons as claim 12, and further in view of the additional features recited therein.

Rejection Over Hughes, Dutta, and Chen, Under 35 U.S.C. § 103

Claims 2-4 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hughes in view of Dutta, in further view of U.S. Patent No. 6,507,856 to Chen et al. (“Chen”). However, the attempted addition of Chen fails to overcome the above-discussed problems with Hughes and Dutta with respect to independent claim 1. Accordingly, claim 2-4 are also allowable.

Moreover, none of Hughes, Dutta, or Chen, alone or in combination, teach or suggest the use of state information as recited in claim 4. Applicant’s specification describes state information as being distinguishable from the mere source/destination addresses of the message:

State information may be contained within <state> tags 416. State information may be used to correlate individual messages with specific exchanges and processes and may include interchange, handle, and state identifiers.

Cole - Serial No.: 09/605,544
Responsive to Office Action of April 21, 2005

Specification, p. 10. Chen briefly mentions the use of source addresses and ship-to addresses to construct a return document, but never describes state information. Chen, Col. 4, lines 40-68. Indeed, the terms "state" or "state information" never appear in Chen, nor does Chen ever suggest generating a return document with data which could be considered state information.

Rejection Over Hughes, Chen, and "Official Notice," Under 35 U.S.C. § 103

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hughes in view of Dutta and further in view of alleged "Official Notice." However, the alleged Official Notice used to reject claim 8 does not overcome the problems discussed above with Hughes and Chen with regard to independent claim 1.

Rejection Over Hughes, Dutta, and Lection, Under 35 U.S.C. § 103

Claims 5, 18, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hughes in view of Dutta, and further in view of Lection. However, the attempted addition of Lection does not overcome the previously discussed problems with Hughes and Dutta with regard to their respective independent claims.

CONCLUSION

All rejections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the Examiner is invited to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 6th day of July, 2005

By:

/Ross Dannenberg/
Ross Dannenberg, Registration No. 49,024
1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001

RAD/BB/mmd